

**REMARKS**

**Preliminary Matters**

Applicants respectfully request that the Examiner acknowledge applicants' claim to domestic priority to U.S. Provisional Application No. 60/227,852.

Applicants thank the Examiner for having granted the personal interview which took place on January 12, 2006. Applicants hereby attach a Statement of Substance of Interview with this Amendment.

Claims 1-4, 7, 8, 10-23, 26-41, 43-55 and 57 are all the claims pending in the application. All the claims currently stand rejected. Independent claims 1, 14, 19, 34, 47, 55 and 57 are amended in view of Applicants' discussion with the Examiner during the personal interview of January 12, 2006. Applicants respectfully submit that claim amendments are made for clarification purposes and that no new matter is added. This Amendment addresses each point of rejections raised by the Examiner, and Applicants hereby respectfully traverse all the rejections.

**Claim Rejections - 35 U.S.C. § 112**

Claims 1, 14, 19, 34, 47, 55 and 57 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which applicants regard as their invention.

Applicants editorially amend claims 1, 14, 19, 34, 47, 55 and 57 to recite that an outside application is executing *on* a data item computer. Applicants respectfully submit that amended claims 1, 14, 19, 34, 47, 55 and 57 fully comply with the requirements laid out by 35 U.S.C. §

112, second paragraph. Therefore, applicants respectfully request withdrawal of the rejections on claims 1, 14, 19, 34, 47 and 57.

Claims 1-4, 7, 8, 10-23, 26-41, 43-55 and 57 also stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to set forth the subject matter that applicants regard as their invention. The Examiner asserts that the claimed “data item computer” recited in each of the independent claims 1, 14, 19, 34, 47, 55 and 57 renders all the claims indefinite (See Office Action: page 2). Applicants respectfully disagrees.

With regards to a rejection based on a failure to set forth the subject matter of the invention, MPEP § 2172 unequivocally states that such rejection is appropriate *only* where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention. In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

The recitation that at least one outside application executes on a data item computer is fully consistent with the subject matter which has been defined and claimed by the applicants all throughout the prosecution history of the present application. Figure 3 of Applicants’ drawings and page 16 of the applicants’ specification unambiguously show that outside applications reside in outside application servers 17-19. Therefore, the noted recitation merely elaborates on what has been known all along in the applicants’ specification that the outside applications push data items 40-42 to the mobile portal server 20 (See Applicants’ Specification: page 16, [0040] -page 17, [0041]). Applicants respectfully submit that a brief reading of the above-referenced portion

of the Applicants' specification will answer the questions<sup>1</sup> raised by the Examiner. There is simply no evidence in the current application that the recitation of a data item computer in each of the independent claims 1, 14, 19, 34, 47, 55 and 57 would render the claims indefinite under 35 U.S.C. § 112, second paragraph.

In view of the foregoing, Applicants respectfully request withdrawal of the rejections on claims 1-4, 7, 8, 10-23, 26-41 and 43-55 and 57. With respect to claims 2-4, 7, 8, 10-13, 15-18, 20-23, 26-33, 35-41, 43-46, 48-53 and 54, applicants respectfully submit that they are patentable at least by virtue of their dependency from independent claims 1, 14, 19, 34 and 47.

**Claim rejections 35 U.S.C. § 103 (a) - claims 1-4, 7, 8, 11-17, 19-23, 26-29, 31-41, 43-45, 47-53, 55 and 57**

Claims 1-4, 7, 8, 11-17, 19-23, 26-29, 31-41, 43-45, 47-53, 55 and 57 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tso et al. (US 6,047,327) in view of Kaplan et al. (US 5,446,891).

Claim 1 recites, *inter alia*, "each received data item is associated with ... an application specific menu corresponding to the at least one *outside application executing on a data item computer*." The Examiner seems to be alleging that "InfoActions" described in Tso disclose the noted features of claim 1 (See Office Action: page 10). Applicants respectfully disagree.

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<sup>1</sup> Questions raised by the Examiner on page 2 of the Office Action.

The combination of Tso and Kaplan fails to teach or suggest the claimed application specific menu which corresponds to an outside application that is executing on a data item computer. Tso is unequivocal in describing<sup>2</sup> that the InfoActions operate on applications (e.g., Infocast browser 89) operating on the *client* and not on an outside data item computer (See Tso: Figure 3; col. 7, lines 32-40; col. 8, line 65 - col. 9, line 65). In sharp contrast, claim 1 plainly recites that the application specific menu interacts with the outside application on the data item computer which is *external* to the terminal of a subscriber. As such, InfoActions described in Tso are distinguishable from the claimed application specific action menu in that the InfoActions are executed within the client subscriber and *not* on an external data item computer that is pushing data items to the subscriber, as recited in claim 1.

Further, applicants respectfully submit that Kaplan fails to make up for the noted deficiencies of Tso. The Examiner cites Kaplan for allegedly disclosing arranging received data items according to a subscriber-selected presentation rule, and as such, lacks any teaching or suggestion of at least the potential association of each data item with an application specific action menu that corresponds to an outside application executing on a data item computer, as recited in claim 1.

In view of the foregoing, applicants respectfully submit that the combination of Tso and Kaplan fails to teach or suggest all of the claimed elements as arranged in claim 1. Therefore, applicants respectfully submit that claim 1 is patentable over Tso in view of Kaplan.

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<sup>2</sup> Tso describes that InfoActions operate on the *client* A 23 through the Infoaction API 87 and the Infocast browser 89 (See Tso: Figure 3).

Consequently, applicants further submit that claims 2-4, 7, 8 and 11-13 are patentable at least by virtue of their dependency from claim 1.

Applicants respectfully submit that claim 14 is patentable over Tso in view of Kaplan based on the rationale analogous to those discussed with respect to claim 1. Applicants further submit that claims 15-17 are also allowable, at least by virtue of their dependency from claim 14.

Applicants respectfully submit that claim 19 is patentable over Tso in view of Kaplan based on the rationale analogous to those discussed with respect to claim 1. Applicants further submit that claims 20-23, 26-29 and 31-33 are also allowable, at least by virtue of their dependency from claim 19.

Applicants respectfully submit that claim 34 is patentable over Tso in view of Kaplan based on the rationale analogous to those discussed with respect to claim 1. Applicants further submit that claims 35-41 and 43-45 are also allowable, at least by virtue of their dependency from claim 34.

Applicants respectfully submit that claim 47 is patentable over Tso in view of Kaplan based on the rationale analogous to those discussed with respect to claim 1. Applicants further submit that claims 48-53 are also allowable, at least by virtue of their dependency from claim 47.

Applicants respectfully submit that claims 55 and 57 are patentable over Tso in view of Kaplan based on the rationale analogous to those discussed with respect to claim 1. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 55 and 57.

**Claim rejections 35 U.S.C. § 103 (a) - claims 10, 18, 30, 46 and 54**

Claims 10, 18, 30, 46 and 54 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tso in view of Kaplan and in further view of Gerace (U.S. Patent No. 5,848,396; “Gerace”).

Claim 10 depends from claim 1, and includes all the recitations of claim 1 by virtue of its dependency. The combination of Tso et al., Kaplan et al. and Gerace does not teach or suggest at least associating each data item with at least an application specific menu that corresponds to an outside application executing on a data item computer, as recited in claim 1. The deficiencies of the combination of Tso et al. and Kaplan et al. have been discussed above with respect to claim 1, and that discussion is incorporated herein by reference.

Gerace describes, *inter alia*, a method of determining a behavioral profile of a computer user, but lacks any teaching or suggestion of at least potentially associating each data item with at least an application specific menu that corresponds to an outside application executing on a data item computer, as recited in claim 1, and included in claim 10 via dependency (See Gerace: col. 2, lines 1-15). Thus, applicants respectfully submit that Gerace fails to make up for the noted deficiencies of Tso and Kaplan.

Although the Examiner asserts that one of ordinary skill in the art would have been motivated to associate a data item (or items) with an application-specific action menu that corresponds to an outside application executing on a data item computer, neither Tso, Kaplan nor Gerace teach or suggest such an association between data items, menus and outside applications executing on a data item computer. Therefore, applicants submit that the Examiner cannot

fulfill the motivation prong of a prima facie case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

In view of the foregoing, applicants submit that the combination of Tso, Kaplan and Gerace fails to teach or suggest all of the claimed elements as arranged in claim 1, and included via dependency in claim 10. Thus, Applicants submit that claim 10 is allowable, and respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claim 10.

Claim 18 depends from claim 14, and includes all the recitations of claim 14 by virtue of its dependency. Applicants submit that claim 18 is allowable for at least reasons analogous to those discussed for claim 10.

Claim 30 depends from claim 19, and includes all the recitations of claim 19 by virtue of its dependency. Applicants submit that claim 30 is allowable for at least reasons analogous to those discussed for claim 10.

Claim 46 depends from claim 34, and includes all the recitations of claim 34 by virtue of its dependency. Applicants submit that claim 46 is allowable for at least reasons analogous to those discussed for claim 10.

Claim 54 depends from claim 47, and includes all the recitations of claim 47 by virtue of its dependency. Applicants submit that claim 54 is allowable for at least reasons analogous to those discussed for claim 10.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

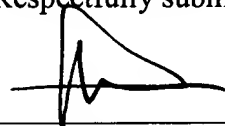
**Amendment Under 37 C.F.R. § 1.116**  
U.S. Application No. 09/832,828

Attorney Docket No.: Q60535

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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